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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,050	01/20/2004	Cliff Chen	MR2349-981	6703

4586 7590 03/22/2007

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ELLICOTT CITY, MD 21043

EXAMINER
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MOON, SEOKYUN

ART UNIT	PAPER NUMBER
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2629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/759,050	<b>Applicant(s)</b> CHEN, CLIFF	
	<b>Examiner</b> Seokyun Moon	<b>Art Unit</b> 2629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. **Claim 3** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 1 and 3** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims disclose that an illumination system is operable independently of an internal circuit of the mouse. However, as shown in fig. 3 of the application and as disclosed in pg 4 lines 18-20 of the specification of the application, the illumination system including light emitting devices 32 is controlled by the switch 34 which is a part of the internal circuit of the mouse. Since the illumination system is controlled by the internal circuit of the mouse, the operation of the illumination system depends on the operation of the internal circuit of the mouse.

Therefore, examiner respectfully submits that the subject matter disclosed in the claims are not consistent with the aspect of the invention disclosed in the specification.

Appropriate correction / explanation is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 3, 4, and 10** are rejected under 35 U.S.C. 102(b) as being anticipated by Daniels (US 6,417,840).

As to **claim 1**, Daniels [fig. 1] teaches a wireless mouse ("*wireless mouse 10*") structure with illumination ("*transmitting a focused beam of light*") [col. 2 lines 31-35], comprising:

a mouse body including an upper case and a lower case [fig. 4]; and

an illumination system [fig. 11] disposed in the mouse body [col. 3 lines 49-51];

wherein the illumination system is operable independently of an internal circuit of the mouse (the operation of the illumination system of the mouse of Daniels does not depend on the operation of the internal circuit which used for inputting information/command to a computer) [col. 4 lines 3-15].

As to **claim 3**, all of the claim limitations have already been discussed with respect to the rejection of claim 1.

As to **claim 4**, Daniels teaches that the illumination system is associated with a control circuit of the mouse [fig. 11], whereby the illumination system is activated through a specific button ("*switch 30*") operation process [col. 4 lines 12-15].

As to **claim 10**, Daniels [col. 3 lines 60-62] teaches the mouse body being provided with a light guide plate ("*45*" or "*46*") [fig. 12] at one end.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2, 5, 6, 8, and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels.

As to **claims 2, 5, and 6**, Daniels teaches the illumination system comprising:

a light emitting device ("*laser generator 42*") [fig. 11] which is disposed in a hole ("*port 24*") [figs. 3 and 4] provided at one end of the mouse body, provided in the illumination system;

a battery set ("*B1*" and "*B2*") [fig. 11] electrically connected to the light emitting device;

and

a switch ("*switch 30*") electrically connected to the light emitting device ("*laser generator 42*") and the battery set ("*B1*" and "*B2*") [fig. 11].

Daniels does not expressly disclose the illumination system to comprise a plurality of light emitting devices.

However, the courts have held that a mere duplication of the components of the device is generally recognized as being within the level of ordinary skill in the art. St. Regis Paper Co. v. Bemis Co. Inc. 193 USPQ 8, 11 (7<sup>TH</sup> Cir. 1977).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the illumination system of Daniels to include a plurality of light emitting devices instead of a single light emitting device and to include a plurality of holes to insert a

plurality of light emitting devices instead of a single hole, in order to enhance the intensity of the light emitted by the illumination system, and thus to provide a better pointing view.

As to **claim 8**, Daniels [col. 1 lines 46-50] teaches that the battery set is disposed in the mouse body, and the battery set is either a battery set exclusively for the mouse or a battery set shared with the wireless mouse.

As to **claim 9**, Daniels teaches the switch ("*switch 30*") [figs. 3 and 4] being disposed on one side of the mouse body.

8. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels in view of Hsu (US 2002/0177467).

Daniels as modified above teaches the plurality of light emitting devices being laser beam generating means [abstract lines 9-11 and lines 15-16].

Daniels does not expressly disclose the plurality of light emitting devices being light emitting diodes.

However, Hsu teaches an apparatus comprising a pointer ("*light emitting element 3*") [fig. 1] which uses a light emitting diode as a light source [abstract lines 7-12].

It would have been obvious to one of ordinary skill in the art at the time of the invention to adopt Hsu's idea of using a light emitting diode as a light source for a pointer, in the device of Daniels, since a light emitting diode is well known for cheap manufacturing-cost compared to the cost for manufacturing a laser beam generating component.

### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seokyun Moon whose telephone number is (571) 272-5552. The examiner can normally be reached on Mon - Fri (8:30 a.m. - 5:00 p.m.).

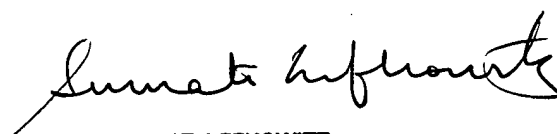
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (572) 272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

03/10/2007

- s.m.

A handwritten signature in black ink, appearing to read "Sumati Lefkowitz", with a stylized flourish at the end.

**SUMATI LEFKOWITZ**  
**SUPERVISORY PATENT EXAMINER**